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Patent
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May 10, 2004

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attn: Art Unit 3625
Patent Examiner Cuong H. Nguyen

Re: Application Serial No.: 09/498,789
Confirmation No.: 9304
Applicants: Ramachandran, et al.
Title: Automated Transaction Machine
Docket No.: D-1096 CIP

Sir:

Please find enclosed Applicants' Response to the Office Action dated April 21, 2004 for filing in the above-identified Application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Response and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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D-1096 CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Ramachandran, et al.

Serial No.: 09/498,789

Confirm. No.: 9304

Filed: February 5, 2000

Title: Automated Transaction
Machine

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Art Unit 3625

Patent Examiner
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Sir:

Reconsideration and withdrawal of the requirement dated April 21, 2004 is respectfully requested.

Appellants Provisionally Elect With Traverse

In response to the Office Action ("Action") dated April 21, 2004 requiring species election, Appellants, as the requirement is best understood, provisionally elect with traverse the alleged species 5. All claims 1-35 are readable on alleged species 5. Furthermore, at least one independent claim is generic.

Reconsideration and withdrawal of said requirement is respectfully requested. The Appellants respectfully submit that the requirement is not legally proper. Thus, the Appeal Brief filed April 25, 2003 remains pending.

The Requirement is not legally proper because it is not timely

The Appellants respectfully submit that the restriction requirement in the Action dated April 21, 2004 is not in compliance with 37 C.F.R. § 1.142 and 37 C.F.R. § 1.146. The time for making a restriction has expired. One of the requirements for a proper restriction requirement is that it be made before a final action (37 C.F.R. § 1.142(a)). Additionally, 37 C.F.R. § 1.146 further requires that a "species" restriction requirement is to be made in the first action on an application. However, a final rejection was made January 29, 2003. Subsequently, a Notice of Appeal was filed March 28, 2003 and an Appeal Brief was filed April 25, 2003. Thus, the requirement is not legally proper.

Furthermore, MPEP § 811 indicates that an examiner is to "make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops." The Office had ample time for making a requirement. The claims on appeal are the original claims. The Appellants did not necessitate any change in the original claim status resulting in a later "need" to make a requirement. The prosecution history is evidence that there never was a "need" for a restriction requirement from initial filing through the Appeal Brief filing. It follows that the "soon as the need" time period for making a restriction requirement has expired. Thus, the requirement is not legally proper and should be withdrawn.

The Requirement is not legally proper because there is no serious burden

MPEP § 803 sets forth criteria for a proper restriction requirement. One of the criteria is that there must be a serious burden on the examiner in order for restriction to be required. Contrarily, if the search and examination of an entire application can be made without serious burden then the examiner must examine it on the merits.

Appellants respectfully submit that the requirement is not legally proper because the criteria for serious burden has not been met. Rather, the prosecution history is evidence that there never was a serious burden. The application has already been searched, there has already been an examination, and the examination was on the merits. Furthermore, as previously mentioned, a final rejection has already been given and an Appeal Brief has already been filed. The prosecution record itself is clear evidence that there was (and continues to be) no serious burden. Thus, the requirement is not legally proper and should be withdrawn.

To allege "serious burden" at this point in the prosecution is ludicrous. Unless the Office has a newly stated policy of waiting for an Appeal Brief before first applying a restriction, then the requirement by the Office must be deemed arbitrary and capricious.

The Requirement is not legally proper as a reasonable number of species are permitted

Appellants are entitled to a reasonable number of species. Even if it were somehow possible for the requirement to have been timely (which it wasn't) and for the examiner to show serious burden (which he can't), 37 C.F.R. § 1.146 still permits an application to have claims directed to a reasonable number of species. Appellants respectfully submit that even if the application had species as alleged, the number of species would still be reasonable, especially in

light of the Office's lack of any evidence to the contrary. Again, the requirement is not legally proper and should be withdrawn.

**The Requirement is not legally proper
because a valid reason for species restriction is absent**

The "mutually exclusive characteristics" (MPEP § 806.04(f)) and the "relationship" (MPEP § 808.01(a)) of the alleged species have not been provided to Appellants. A valid reason why the alleged species are distinct is absent in the Action.

In accordance with MPEP § 806.04(f), claims to be restricted to different species must be mutually exclusive. The "general test" as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which are found in a first species but not in a second species, while a second claim recites limitations only for the second species and not the first species. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

The Action has not indicated which claim recites limitations which are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first, as is required in order to meet the noted "general test" of MPEP § 806.04(f).

Where does the Action demonstrate that the alleged species are mutually exclusive (MPEP § 806.04(f))? For example, where does the Action show that the alleged species are prevented from being used in the same embodiment? The Action has not shown that each alleged specie cannot be used in an embodiment with another alleged specie. Rather, the

Action's own allegations are contrary to the general test for species being mutually exclusive. For example, the Action alleges that species 5 can use an image, yet the Action also alleges that species 3 permits use of an image. Where does the Action show that the other alleged species are specifically prevented from be used with an image (such as alleged species 5)? Where does the Action provide a reason why the alleged species 3 (which according to the Action permits an image) and the alleged species 5 (which according to the Action permits an image) are mutually exclusive species? According to the Action it would appear that one of the alleged species 3 and 5 would encompass the other. Therefore, the Action has not met the general test for mutually exclusive species. It follows that the Action has not met the test for a proper species restriction requirement. Thus, the requirement is improper and should be withdrawn.

Nor has the Office demonstrated where the alleged species occur in the claims, nor the common characteristic linking each of the alleged species. Appellants respectively disagree with the Actions' allegations and descriptions of species. For these reasons it is respectfully submitted that there is no valid basis for requiring species election. Thus, it is respectfully submitted that the requirement should be withdrawn.

The Requirement is not legally proper because it is incomplete/unclear

The Action does not meet the species restriction requirement criteria set forth in MPEP § 809.02(a). The Action does not "Identify generic claims or indicate that no generic claims are present" in accordance with MPEP § 809.02(a). Where does the Action state the status of generic claims? It doesn't. Because the Requirement does not properly address the issue of

generic claims, Appellants have been denied information critical to their election decision. That is, Appellants have not been given a fair opportunity to make an informed election.

Nor does the Action clearly identify each of the alleged species to which claims are restricted in accordance with MPEP § 809.02(a). Where does the Action state how the alleged species are directed to different embodiments? Where does the Action correlate the claimed subject matter to the alleged species? For example, which claim(s) corresponds to identifying a merchant based on image and manual inputs (i.e., alleged species 1)? Which claim(s) corresponds to identifying a merchant based on voice and manual inputs (i.e., alleged species 2)? Again, Appellants have not been given a fair opportunity to make an informed election.

The requirement does not properly describe the alleged distinct species. Nor are the alleged species clearly and properly presented. The Office is specifically requested to answer (1) where the alleged species occur in the claims, and (2) what is the common characteristic linking the alleged species? The Action leaves Appellants the burden of responding to an unclear and improper requirement. Again, Appellants have not been given a fair opportunity to make an informed election. On this basis it is respectfully submitted that the requirement should be withdrawn.

The Action does not present a species restriction requirement based on the laws, rules, and Patent Office procedures. The Action at best pertains to a puzzle of non fitting species allegations. The Action also appears to obfuscate the issues, because there is no proper species requirement to be made. For these reasons it is respectfully submitted that the requirement is improper. As there is no valid basis for requiring the species election requirement, it is respectfully submitted that the requirement should be withdrawn.

Appellants, as the requirement is best understood, have provisionally elected with traverse. However, Appellants reserve all rights to change or modify the election based on the alleged species requirement presentation being made a clearly understood and proper requirement.

All claims 1-35 are readable on alleged specie 5

The alleged specie 5 is listed in the Action as "A processor uses merchant's captured image without needing manual inputs for identification." As previously discussed, the Action is silent as to where the alleged specie 5 occurs in the claims (which renders the requirement improper). The claims are not directed to a "processor" alone, as the requirement apparently alleges. Additionally, the term "needing" does not appear in the claims. Thus, the meaning of the requirement's "needing" is indefinite. It follows that the description of alleged specie 5 is likewise indefinite. Again, Appellants have not been given a fair opportunity to make an informed election.

The Appellants, as the unclear Action is best understood, interpret "species 5" to read on any claim that can include a processor that can use an image, such as for identification purposes, whether or not manual input is used. Also, just because the processor of "species 5" can use an image does not limit it to requiring an image (e.g., a processor can use another feature instead of an image) and/or only using an image (e.g., a processor can use an image combined with another feature).

Each claim recites a processor. Nothing in the claims prevents the processor from using an image, especially for identification purposes. For example, claim 18 has a processor that can

use an image, as nothing in the claim prevents the physical feature from being an image. Likewise, nothing in claim 32 prevents the processor from using an image. It follows that all of the claims read on the alleged species 5.

The reference to the Appeal Brief

The Action alleges that the Appeal Brief at page 4, second paragraph, asserts that there are at least two different species of invention. The Appellants respectfully disagree with the alleged allegation. The ability of a processor apparatus to perform plural processes does not necessarily result in plural distinct species.

**No legal basis for reopening prosecution
to apply a restriction requirement after the filing of an Appeal Brief**

Appellants respectfully submit that the rules permit prosecution to be reopened after the filing of an Appeal Brief in order to introduce a new ground of rejection, not to merely introduce a restriction requirement (which is the current situation). Appellants have not been given the opportunity to exercise their rights in accordance with 37 C.F.R. § 1.193 (b)(2). With a reopening of prosecution after an Appeal Brief, then Appellants would be entitled to the options set forth in MPEP § 1208.02. As the Action does not make these options available to Appellants, then the Action cannot constitute a reopening of prosecution. As best understood, prosecution has not been reopened. Thus, Appellants' Appeal Brief remains active and pending.

Request For Clarification

Appellants respectfully request clarification of the status of the pending application. It is unclear from the record whether prosecution has been reopened. Where does the Action specifically state that prosecution has been reopened? The Action merely states that "The examiner withdraws the Final Office Action mailed 1/29/2003" (i.e., a final rejection). However, a final Action (e.g., a final rejection) is not necessary for the filing of an appeal. Rather, a "notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected" (MPEP § 1205). Thus, a withdrawal of the final rejection dated 1/29/2003 has no effect on reopening prosecution. The withdrawal of the final rejection has been treated as a notification by the Office that all claims have been allowed (i.e., no rejection is pending).

Furthermore, the Office's own procedures for examination (e.g., MPEP § 1208.01 and 1208.02) state that supervisory approval is required in order to reopen prosecution after Appellants' Appeal Brief has been filed. However, there is no evidence of record of supervisory approval for reopening prosecution. Appellants request such evidence (if it exists).

Additionally, if prosecution had been reopened, then Appellants would be entitled to the options set forth in MPEP § 1208.02. However, these options are not currently available to Appellants, which is further indication that prosecution had not been reopened.

As best understood, prosecution has not been reopened. Appellants' Appeal Brief remains active and pending. With no rejection pending, all claims are deemed allowed. The Office's inferred indication of all claims being allowed is acknowledged. Since all claims stand

allowed, this application is in condition for allowance. Thus, a Notice of Allowance is respectfully requested.

Conclusion

The species requirement is respectfully traversed. The species requirement is not proper. Therefore, reconsideration is requested and it is respectfully requested that the species requirement be withdrawn. Appellants further respectfully submit that this application is in condition for allowance.

The undersigned will be happy to discuss any aspect of the application by telephone at the Office's convenience.

Respectfully submitted,



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